

08-08-02

CP/1645

Docket No: AM100249
Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re of Application of: **CHU, et al.**
Serial No.: **10/039,383** Group Art No.: **1645**
Filed: **December 17, 2001** Examiner: **S. Devi**
For: **IMPROVED MYCOPLASMA HYOPNEUMONIAE BACTERIN
VACCINE**
Confirmation No.: **3951**
Customer Number: **25291**

Commissioner for Patents
Washington, DC 20231

August 7, 2002

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AUG 09 2002

TECH CENTER 1600/2900

Sir:

TRANSMITTAL LETTER

1. Enclosed please find the following documents for the above-identified application:

Response to Office Action mailed on **July 8, 2002**

CERTIFICATE OF MAILING 37 CFR §1.10

I hereby certify that this paper and the documents referred to as enclosed therein are being deposited with the United States Postal Service on the date written below in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number **EV100596166US** addressed to the Commissioner for Patents, Washington, DC 20231.

August 7, 2002
Date


Karen L. Reilly
Karen L. Reilly

2. We believe no fees are due for the attached Response to Restriction Requirement.
However, if fees are applicable,

☒ Please charge Deposit Account No. 01-1425.

The Commissioner is hereby authorized to charge any additional fees required by this paper, including the enclosed documents, and during the entire pendency of this application and to credit any excess amounts paid to Deposit Account No. 01-1425. A copy of this letter is enclosed for use by the Deposit Account Branch.

Respectfully submitted,



Barbara L. Renda
Attorney for Applicants
Reg. No. 27,626

Wyeth
Patent Law Department
Five Giralda Farms
Madison, NJ 07940-0874
Tel. No. (973) 683-2153



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DOCKET NO. AM100249
PATENT

#4
Linda
8/13/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): CHU et al.

EXAMINER: S. Devi

SERIAL NO.: 10/039,383

ART UNIT: 1645

FILED: December 17, 2001

FOR: IMPROVED MYCOPLASMA HYOPNEUMONIAE BACTERIN VACCINE

RESPONSE TO RESTRICTION REQUIREMENT

COMMISSIONER FOR PATENTS
BOX NON-FEE AMENDMENT
WASHINGTON, DC 20231

Dear Sir:

This is in response to the Office Action of July 8, 2002, to which a response is due August 8, 2002, comprising a Requirement for Restriction as between the following various inventions, designated I – II by the Examiner.

- I. Claims 1-9 and 18, drawn to a vaccine comprising *Mycoplasma hyopneumoniae* bacterin, class 424, subclass 93.4.
- II. Claims 20-17, drawn to a method for protecting an animal against disease caused by *Mycoplasma hyopneumoniae* by administering a vaccine comprising *Mycoplasma hyopneumoniae* bacterin, class 424, subclass 263.1.

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date written below in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number EV100596166US addressed to the COMMISSIONER FOR PATENTS, WASHINGTON, DC 20231.

Karen L. Reilly

Date) August 7, 2002

It is the position of the Examiner that "inventions I and II are related as product and process of using the product" and the "*Mycoplasma hyopneumoniae* of invention I can be used in a materially different process, for example, in an *in vitro* diagnostic test as a coating antigen."

Responsive to this Requirement, Applicants, with traverse, elect the invention designated as Group II by the Examiner, *i.e.*, Claims 10-17, drawn to a method for protecting an animal against disease caused by *Mycoplasma hyopneumoniae* by administering a vaccine comprising *Mycoplasma hyopneumoniae* bacterin.

Under 35 U.S.C. §121 "two or more independent and distinct inventions ... in one application may ... be restricted to one of the inventions." Inventions are "'independent'" if "there is no disclosed relationship between the two or more subjects disclosed" (MPEP 802.01). The term "'distinct'" means that "two or more subjects as disclosed are related ... but are capable of separate manufacture, use or sale as claimed, and are patentable over each other" (MPEP 802.01). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

Under Patent Office examining procedures, "If the search and examination of an entire application can be made without serious burden, the Examiner is encouraged to examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988).

In the present instance, the central aspect of all the claims is the preparation of a vaccine and its use to protect an animal from disease. The non-elected group of claims are drawn to the vaccine *per se*. It would therefore follow that a search directed to the particular

method of using the vaccine would extend to the relevant areas of classification where the vaccine *per se* would be searched, and *vice versa*. In view of this, Applicants urge that the restriction be withdrawn and that all of the claims of record be examined simultaneously.

No fees are believed to be due for this response. However, should this be in error, authorization is hereby given to charge Deposit Account 01-1425 for any additional fees due.

For the above reasons, Applicants request withdrawal of the Requirement for Restriction, and early action on the merits as to claims 10-17, presently pending in the case.

Respectfully submitted,



BARBARA L. RENDA
Attorney for Applicant(s)
Registration No. 27,626

Wyeth
Patent Law Department
Five Giralda Farms
Madison, New Jersey 07940
Tel. No. (973) 683-2153